

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 09/785,528

Claims 3, 4, 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato et al. in view of Torimoto and Yoshida et al. as applied to claims 1, 6 and 9, and further in view of Maeno et al. (USP 5,585,685);

Claims 5 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato et al. in view of Torimoto and Yoshida et al. as applied to claims 1, 6 and 9, and further in view of “common knowledge in the art.”

At least because the examiner has failed to set forth an appropriate *prima facie* case of obviousness and, moreover, because the cited prior art references fail to teach or suggest, either alone or in any reasonable combination, the terminal holder and the annular conductors and insulating layers, as recited in independent claim 1; the terminal holder and annular electric conductors, as recited in independent claim 6; and the annular conductors and insulating layers, as recited in independent claim 9, Applicant respectfully traverses the prior art rejections and requests favorable reconsideration and disposition of all claims, claims 1-11.

***Lack of Prima Facie Case***

In regard to the rejection of claims 1, 6 and 9 as being obvious in view of the teachings of Sato et al., Torimoto and Yoshida et al, the examiner has failed to set forth a *prima facie* case of obvious under 35 U.S.C. §103. In particular, the examiner has not identified any structural components from any of the asserted references that meet the recited requirements of the *annular electric conductors*.

On page 3 of the Office Action the examiner recognizes that Sato et al. “fails to disclose the use of annular conductors”. However, in the immediately preceding paragraph, in regard to

the *wherein* clause of claims 1, 6 and 9, the examiner asserts that Sato et al. discloses that “said annular electric conductors are provided with a connecting portion . . .”. This contradiction is irreconcilable. Clearly, Sato et al. cannot both fail to disclose the claimed annular conductors yet at the same time disclose the annular conductors.

Thus, because the examiner has not identified where, in any of the asserted references, the claimed annular conductors “provided with a connecting portion for connecting terminal lead wires of said stator winding corresponding to lead positions of said terminal lead wires” are disclosed, a *prima facie* case of obviousness has not been properly set forth. For at least this reason, the §103 rejection of claims 1, 6 and 9, and all claims dependent thereon, specifically, claims 2-4, 7-8 and 10-11, respectively, should be withdrawn.

***Lack of Recited Elements***

The examiner asserts that Yoshida et al. discloses the claimed *terminal holder* recited in each of claims 1, 6 and 9, respectively. For the following reasons, Applicant respectfully disagrees and submits that the terminal holder as required by each of claims 1-11 is neither taught, or otherwise suggested, by the asserted combination of references.

Specifically, claims 1 and 6 recite, *inter alia*, “a terminal holder fixed to said flange portion of said bobbin-shaped insulator and provided with a cylinder portion arranged so as to surround said rotary shaft”. As disclosed at column 3, lines 39-40, the *terminal unit* 41 of Yoshida et al. includes a “cylindrical male-connector 41a for connecting [an] integral circuit to the outside.” However, neither the terminal unit 41 nor the male-connector 41a is provided with

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a “cylindrical portion arranged so as to surround the rotary shaft”, as explicitly required by claims 1 and 6. (see e.g., figs. 2 and 4c).

None of the other cited references compensate for the above-cited deficiency in Yoshida et al. Accordingly, the proposed combination of references, Sato et al., Torimoto and Yoshida et al., does not teach or suggest all of the elements of either claim 1 or claim 6 and, thus, the §103 rejection of claims 1 and 6, and all claims dependent thereon, specifically, claims 2-5 and 7-8, respectively, should be withdrawn.

Additionally, each of claims 1-5 require *annular conductors and insulating layers* arranged on the outer diameter of the cylinder portion of a terminal holder. The conductors and insulating layers must also be laminated in the axial direction. As best can be understood, in view of the confusing contradiction described above in regard to whether or not the examiner is asserting that Sato et al. discloses the claimed annular conductors, the examiner asserts that conductors 34a of Sato et al., as modified by the teachings of Torimoto, meet this recited requirement. Applicant respectfully disagrees, however, and submits that neither Sato et al. nor Torimoto disclose the annular conductors as claimed.

In particular, structure 34a in Sato et al. is described at column 5, lines 6-7, as “protruding portions 34a on the outer surface of the flange 30”. Structure 34a is, thus, not a conductor, as required by the claims and, furthermore, structure 34a is not laminated in the axial direction with annular insulating layers. Also, contrary to the assertions of the examiner, the conductors 4 disclosed in Torimoto are not annular. Thus, even if the teachings of Torimoto were combined with those of Sato et al., the result would not meet the requirements of the

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claims. For this additional reason the proposed combination of references does not teach or suggest the limitations recited by claims 1-5 and, accordingly, the rejection to these claims should be withdrawn.

In claims 6-8, the recited annular conductors are stored in grooves on the outer diameter of the cylinder portion of the terminal holder. Nothing in any of the asserted references, Sato et al., Torimoto and Yoshida et al., teaches or suggests this required limitation and, accordingly, the rejection of claims 6-8 should be withdrawn.

Lastly, in regard to claims 9-11, as described above, neither Sato et al. nor Torimoto teach or suggest the recited annular connectors and insulating layers. Contrary to the examiner's assertions, Sato et al. does not disclose conductors laminated to insulating layers in the axial direction and, furthermore, Torimoto does not disclose annular conductors or annular insulators. Yoshida et al. does not compensate for this deficiency. For at least this reason, the rejection of claims 9-11 should be withdrawn.


***Conclusion***

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 1-11, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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